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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,122	04/18/2001	Julie B. Brumbelow	19133.0006U3	7378

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No	Applicant(s)	
	09/837,122	BRUMBELOW ET AL.	
	Examiner	Art Unit	
	Cheryl Juska	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 29 September 2003.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 20,24-30,34-37,39 and 40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 20,24-30,34-37,39 and 40 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on September 29, 2003, has been entered. Claims 1-19, 21-23, 31-33, and 38 are cancelled, claims 20 and 24 are amended, and new claim 40 is added as requested. Thus, the pending claims are 20, 24-30, 34-37, 39, and 40.
2. The cancellation of said claims renders moot the rejections set forth in the last Office Action, sections 1-6.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 40, 20, 24-27, 29, 30, 34-37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/22414 issued to Materniak et al. in view of US 4,844,765 issued to Reith.

New independent claim 40 contains the limitation of cancelled claims 19, 21, 22, and 33. Additionally, claim 40 includes the limitation that the thermoplastic polymer layer is extruded at a temperature of 400-550°F. Claims 19, 21, and 33 were previously rejected under 102 as being anticipated by Materniak, while claim 22 was rejected under 103 as being obvious over Materniak in view of Reith. Thus, new claim 40 is rejected for reasons analogous to those presented in the rejection of claim 22 (section 5 of the last Office Action), with the additional following arguments

Materniak does not explicitly teach an extruded coating. However, the polymers employed in the coating for the secondary backing of Materniak (i.e., EVA and polyacrylates) are well known in the art as extrudable. Applicant is hereby given Official Notice of this fact. Thus, it would have been obvious to one skilled in the art to extrude the polymer of Materniak onto the secondary backing. Motivation to do so would be to eliminate the need for the time- and energy-consuming drying steps associated with latex application. Additional motivation is found in the smoother surface obtained from an extruded layer.

With respect to the limitation of the particular thermoplastic polymer composition, it is argued that said limitation is a structural limitation in a method claim. As such, said limitation is not given patentable weight at this time. It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31.

Additionally, the cited prior art does not explicitly teach the claimed extrusion temperature for the claimed thermoplastic polymers. However, it is argued said limitation is obvious to one skilled in the art. Specifically, one skilled in the art is readily able to determine an appropriate extrusion temperature for a specified polymer, since said temperature is dependent upon the inherent melting temperature of said polymer. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Therefore, claims 40, 20, 24-27, 29, 30, and 34-37 are rejected as being obvious over the cited prior art.

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5. Claims 28 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Materniak and Reith references, as applied to claim 40 above, and in further view of US 5,540,968 issued to Higgins.

Said claims are rejected for reasons analogous to those presented in section 4 of the last Office Action.

Response to Arguments

6. Applicant's arguments filed with the amendment of September 29, 2003 have been fully considered but they are not persuasive.

7. Applicant argues that the prior art does not teach the claimed reduced coefficient of friction limitation and that the examiner has not provided evidence of the inherency argument presented in the last Office Action. In response, it is noted that a secondary backing having a coating that meets the structural and chemical limitations of the presently claimed invention, must inherently possess the same properties as the instant invention. In other words, "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 15 USPQ2d 1655. Since no evidence has been presented to the contrary, one must presume the coefficient of friction limitation is inherent to the invention of the cited prior art, since said prior art has the same structural and chemical composition as the present invention.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
December 29, 2003